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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,538	12/19/2005	Takashi Fujita	053362	9367
38834 7590 05/29/2009 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
XU, XIAOYUN				
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1797				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/561,538

## Applicant(s)

FUJITA ET AL.

## Examiner

ROBERT XU

## Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-13, 15, 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 14, 16, 17 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The amendment filed 04/23/2009 has been entered and fully considered. Claims 1-20 are pending, of which Claims 8-13, 15, 18 and 19 are withdrawn from consideration, Claims 1-7, 14, 16 and 17 are amended, claim 20 is newly added.

### ***Response to Amendment***

2. In response to amendment, the examiner withdraws objection and 35 USC 112, second paragraph rejection, and maintains rejection over the prior art established in the previous Office action.

### ***Claim Rejections – 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. **Claims 1-5, 7, 14-16 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over McCaffrey et al. (US 2001/0038450) (McCaffrey) in view of Ryoji (Engineering Materials, 1999).

In regard to Claims 1, 7, 14 and 15, McCaffrey teaches determining amount of ATP by detecting ATP-luciferase chemi-luminescence (see paragraph [0004]). McCaffrey teaches that the photo-detecting transducers used for detecting luminescence are very sensitive to static charge; for instance, static charges seen when a sample consumable is inserted into the sample chamber (compartment) (see col. 2, paragraph [0015]). McCaffrey further teaches that conventionally, a sample chamber (compartment) of known devices must be made of a conductive material or some other means must be provide to remove static charge from the sample chamber (see paragraph [0015]). McCaffrey does not specifically teach what "some other means" are.

Ryoji teaches static elimination materials that can be used to eliminate static in the air (see title). At time of the invention, it would have been obvious to ordinary skill in the art to use static elimination materials to remove static electricity in the air as taught by Ryoji before the air enters McCaffrey's sample chamber, because McCaffrey teaches

the detecting luminescence are very sensitive to static charge and other means must be provide to remove the static charges.

In regard to Claims 2-5 and 16, Ryoji teaches prevention of product troubles by static electricity failure, removal of static electricity by using materials having a static elimination effect (see abstract). At time of the invention, it would have been obvious to one of ordinary skill in the art to remove static electricity by materials having a static elimination effect as taught by Ryoji in McCaffrey's measurement chamber so that the static inside the chamber can be removed.

In regard to Claim 20, McCaffrey teaches calibration of the instrument (see paragraph [0052]). McCaffrey in view of Ryoji does not specifically teach using a calibration curve showing a relationship between a concentration of the objective compound and a measured value which is previously obtained by measuring a standard solution containing a known amount of the objective component. However, using a calibration curve based on a known amount of the compound is well known in the art, at the time of the invention it would have been obvious to one of ordinary skill in the art to use a calibration curve showing a relationship between a concentration of the objective compound and a measured value which is previously obtained by measuring a standard solution containing a known amount of the objective component.

5. **Claims 6 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over McCaffrey in view of Ryoji as applied to Claims 1-5, 7, 14, 16 and 20 above, and further in view of Rapp et al. (US Patent 6,602,464) (Rapp).

In regard to Claims 6 and 17, McCaffrey in view of Ryoji does not teach shutting an opening part of the reaction vessel with a sheet or a method for covering the surface of the solution in the reaction vessel with a substance insoluble to the solution. Oil layer has been used to seal the surface of aqueous solution in the art, because oil is insoluble to water and oil is lighter than water. For example, Rapp teaches using oil layer to seal the surface of surface of liquid animal waste (see Col. 2, lines 33-39). At time of the invention it would have been obvious to ordinary skill in the art to use oil layer to seal the surface of solution in the reaction vessel as taught by Rapp, in order to prevent the electrostatic charge from interfering with the measurement, because McCaffrey teaches

that some other means must be provide to remove static charge from the sample chamber (see paragraph [0015]). Sealing an opening part of the reaction vessel with a sheet to prevent the solution inside the vessel from contacting outside is well known in the art. At the time of the invention it would have been obvious to ordinary skill in the art to seal the opening of the vessel with sheet in order to prevent the solution inside the vessel from contacting the static charge as taught by McCaffrey and art.

### ***Response to Arguments***

6. Applicant's arguments filed 04/23/2009 have been fully considered but they are not persuasive.

Applicants argue that Ryoji discloses the use of "Novalloy E series" only for paper feeding mechanism, air cleaner etc. IC manufacturing, paper feeding mechanism and air cleaners are examples of what static elimination material taught by Ryoji can do in eliminating static in the air. Therefore, using static elimination material inside McCaffrey's photo chamber to make an atmosphere surrounding a reaction vessel in a photo chamber electrically constant (no static) would have been obvious to one of ordinary skill in the art, because McCaffrey teaches a need of eliminating static inside the photo chamber.

Applicants argue that Rapp discloses treating agriculture animal waste to minimize odorous emissions. The treatment includes the use of oil and activated carbon applied to the surface of liquid animal waste. Thus, the Applicants argue that the art of treating agricultural waste is not reasonably pertinent to the art of the present invention. The applicant is advised that the rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. (see *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)). Sealing aqueous surface with oil film is knowledge generally available to one of ordinary skill in the art as demonstrated by Rapp.

Applicants argue that "it is not well known in the art to shut an open part of the reaction vessel when the luminescence is measured, and the Office Action has not provided an evidence to demonstrate that this feature is well known". Office Action states that "sealing an opening part of the reaction vessel with a sheet to prevent the solution inside the vessel from contacting outside is well known in the art". Therefore, Office has no obligation to provide an evidence to demonstrate the feature "shut an open part of the reaction vessel when the luminescence is measured". It would have been a common practice in the art to seal the opening of the vessel with sheet in order to prevent the solution inside the vessel from evaporating or being contaminated.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **ROBERT XU** whose telephone number is **(571)270-5560**. The examiner can normally be reached on **Mon-Thur 7:30am-5:00pm, Fri 7:30am-4:00pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie Kim can be reached on **(571)272-0579**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

5/27/2009

/Yelena G. Gakh/  
Primary Examiner, Art Unit 1797

RX